

## **REMARKS**

In this response to the Office Action dated May 28, 2009, Claims 1, 7, 9, 15, 19, 38, and 39 have been amended. Claims 1, 7, and 15 have been amended to remove limitation related to at least 95% identity. Claims 7 and 9 have been amended to describe the subject matter more clearly. Claim 19 has been amended and support for this amendment can be found, for example, from Figure 11 (i.e. the transgenic plant harboring -368 bp fragment). Claims 38 and 39 have been amended and supports for these amendments can be found, for example, from Example 5 and its related description in the specification as originally filed. As such, no new matter has been added. Claims 1, 7, 9, 11-15, 19-21, and 26-39 are currently pending in the application. In view of the amendments and comments as set forth herein, Applicants respectively request reconsideration and withdrawal of the claim rejections.

### **Objection to Claims**

In the Office Action, the Examiner set forth objections to Claims 7 and 9 for allegedly being unclear. In this response, Applicants have amended Claim 7 in a way that is in line with the Examiner's suggestion. Regarding Claim 9, Applicants have amended the Claim to further specify the method as described in series of experiments illustrated in the subject specification. In Examples 1 to 5 of the present application, the promoter region was isolated as a 4 kb fragment using an inverse PCR. In these Examples, a fragment of genomic DNA comprising the known 5' of the ACC synthase gene was circularized and primers pairs that are designed to hybridize in opposite orientations to the known region are used to amplify the entire intervening circular strand, generating the sequence comprising the promoter. As such, the amended Claim 9 is fully supported by the specification as filed and more explicitly discloses the subject matter. In light of the amendments to Claim 7 and 9, Applicants respectively request withdrawal of the objections to the claims.

### **Rejection of Claims 38 and 39 under 35 U.S.C. 112, first paragraph**

In the Office Action, the Examiner rejected claims 38 and 39 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Applicants respectfully disagree with the Examiner's rejection. Nevertheless, in the interests of furthering

prosecution, Applicants have amended Claims 38 and 39 to recite additional 5' sequences (i.e. nucleotides 2298 to 2473), such that the claims are now clearly supported by the specification as filed. Applicants noted that Example 5 of the specification describes the deletion fragments as "starting from 170 base pairs upstream of the first ATG codon". This description together with the following description of the promoter fragment in the specification is clear evidence that the deletion fragments encompass the 5' UTR. In Example 5, nine promoter fragments are referred to on page 37, lines 26 and 27 of the specification as 0.17, 0.23, 0.45, 0.70, 0.88, 1.1, 1.8, or 2.5 kb fragments. In Figures 11 and 12, the promoter fragments are referred to variously as -86, -131, -386, -611, -783, -1027, -1565, and -2383. The promoter fragments referred to in Example 5 related to an upstream (5') promoter sequence portion (that extends to the transcription start site at "1") followed by 85 base pairs of 5' UTR. Subtraction of the 5' UTR 85 base from the size of the promoter fragments referred to in Example 5 provides approximately the promoter fragment sizes referred to in the Figures ( $170-85=85$ ,  $230-85=145$ ,  $450-85=365$  etc). Thus, Example 5 makes explicit reference to the 5' UTR within the deletion fragments.

In light of the amendments and remarks above, Applicants respectfully submit that Claims 38 and 39 are in compliance with the requirement under 35 U.S.C. § 112, first paragraph. Reconsideration of Claims 38 and 39 is respectfully requested.

#### **Rejection of Claims 1, 7, 9, 11-15, and 19-21 under 35 U.S.C. 112, first paragraph**

In the Office Action, the Examiner rejected Claims 1, 7, 9, 11-15, and 19-21 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Regarding this rejection, the Examiner asserted that a person of ordinary skill in the art could not predict the operability of the species that are 95% related to a fragment comprising residues 2298-2384 of SEQ ID NO:3. While Applicants disagree with this Examiner's assertion, solely to expedite the prosecution and render the pending claims readily allowable, Applicants have removed the recitation of 95% identity from Claim 1, 7, and 15. As such, Applicants believe that Claims 1, 7, 15 and their dependent Claims, 9, 11-14, and 19-21 are now fully enabled by the specification. Applicants respectfully request the Examiner's reconsideration of the rejected Claims 1, 7, 9, 11-15, and 19-21 for immediate issuance.

**No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**CONCLUSION**

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above.

In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: /daniel altman/  
Daniel E. Altman  
Registration No. 34,115  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404